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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,270	01/19/2001	Takamichi Sekido	01028/LH	1334
1933	7590	11/29/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			NGUYEN, CHAU T	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/766,270

Applicant(s)

SEKIDO ET AL.

Examiner

Chau Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5, 7, 11, 12, 22, 23, 27 and 29-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 7, 11, 12, 22, 23, 27 and 29-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/12/2005 has been entered. Claims 3-5, 7, 11-12, 22-23, 27 and 29-55 are presented for examination.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-5, 7, 12, 22-23, 29-33, 35-36, 38-42, 44-45, 47-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conrad et al. (Conrad), US Patent No. 6,307,545, and further in view of Takeda et al. (Takeda), US Patent No. 6,549,302.

4. As to claims 32 and 41, Conrad discloses a document handling apparatus for editing document file data, comprising:

a display which displays in a list window area a plurality of document icons/thumbnails corresponding to registered document files each including a plurality of pages, and which displays in a palette window area page icons/thumbnails corresponding to the plurality of pages of at least one selected registered document file corresponding to at least one selected icon/thumbnail in the list window area (col. 1, lines 32-57 and col. 4, lines 5-28: a display system 18 displaying a plurality of windows enclosed identifiers or icons (thumbnails) such as icons 26 and 27 in window 23, icons 28-30 in window 24 and icon 31 in window 25, and icons are shown as graphical elements and icons may also be textual elements (document files), such as the name of the corresponding object (page), and col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure); and

a file controller which picks up desired pages of the plurality of pages of the at least one selected registered document file based on a designation of page icons/thumbnails in the palette window area corresponding to the desired pages (col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B)

However, Conrad does not explicitly disclose a file controller which unifies the picked up individual pages to generate a new document file and a corresponding new

document file icon/thumbnaill based on the picked up individual pages. Takeda discloses a method that enables a user to divide (division process) one document into plural pages or combine (unification process) several documents into one (col. 14, line 18 – col. 15, line 53). Takeda also discloses that document can be divided at specified page such that Document 1 includes 3 pages, each page is considered as an individual page (col. 6, lines 55-67 and Fig. 6). In addition, Takeda discloses that using combination instruction and division instruction (file controller) from the menu on display screen to combine document and divide document, respectively (col. 14, lines 18-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Takeda and Conrad to include a file controller which unifies the picked up individual pages to generate a new document file and a corresponding new document file icon/thumbnaill based on the picked up individual pages. Takeda provides an image processing system, which can read manuscripts/documents and carry out image processing on the basis of the management information corresponding to the images of the read documents.

5. As to claim 3, Conrad-Takeda disclose wherein said each registered document file corresponds to file data stored in a memory (Conrad, col. 3, line 57 – col. 4, line 25 and col. 12, lines 15-47).

6. As to claims 4 and 22, Conrad-Takeda disclose wherein said file controller exports the new document file icon form the palette window area into the list window area (Conrad, col. 6, lines 10-31).

7. As to claims 5 and 23, Conrad-Takeda disclose wherein the new document file is outputted by an operation of the new document file icon/thumbnail in the palette window (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

8. As to claims 7 and 29, Conrad-Takeda disclose wherein said file controller creates a duplicated file of the at least one selected registered document (Takeda discloses a method that enables a user to divide (division process) one document into plural documents or combine (unification process) several documents into one (col. 14, line 18 – col. 15, line 53. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Takeda and Conrad to include file operation means for executing a page division process or a page unification process of document file on the basis of an operation for the icon/thumbnails shown on said palette window area. Takeda provides an image processing system which can read manuscripts/documents and carry out image processing on the basis of the management information corresponding to the images of the read documents).

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9. As to claim 30, Conrad-Takeda disclose displaying page icon/thumbnails corresponding to each divided page in the palette window area (Conrad, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure).

10. As to claims 33 and 42, Conrad-Takeda disclose wherein the new document file has a predetermined file format (Conrad, col. 4, lines 21-18).

11. As to claims 35 and 44, Conrad-Takeda disclose wherein said each registered document file includes icon/thumbnail data and a document file having a predetermined file format and including the plurality of pages of the registered document file (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

12. As to claims 12, 31, 36 and 45, Conrad-Takeda disclose wherein the new document file has the predetermined file format, and the new document file is generated based on the document file having the predetermined file format (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

13. As to claims 38 and 47, Conrad-Takeda disclose wherein the picked up pages are picked up from one said selected registered document file (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

14. As to claims 39 and 48, Conrad-Takeda disclose wherein one of the picked up pages is picked up from one said selected registered document file, and another of the picked up pages is picked up from another said selected registered document file (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

15. As to claims 40, 49, 51 and 53, Conrad-Takeda disclose wherein the file controller generates the new document file in accordance with an operation of moving the new document file icon/thumbnaill from the palette window area to the list window area (Conrad, Abstract, col. 1, lines 32-57 and col. 4, lines 5-28: a display system 18 displaying a plurality of windows enclosed identifiers or icons (thumbnails) such as icons 26 and 27 in window 23, icons 28-30 in window 24 and icon 31 in window 25, and icons are shown as graphical elements and icons may also be textual elements (document files), such as the name of the corresponding object (page), and col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure).



16. As to claims 54 and 55, Conrad-Takeda disclose wherein the file controller generates the new document file based on the picked up pages (Conrad, Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B).

17. As to claims 50 and 52, Conrad discloses a document handling apparatus for editing document file data, comprising:

a display which displays a list window area and a palette window area (col. 1, lines 32-57 and col. 4, lines 5-28: a display system 18 displaying a plurality of windows enclosed identifiers or icons (thumbnails) such as icons 26 and 27 in window 23, icons 28-30 in window 24 and icon 31 in window 25, and icons are shown as graphical elements and icons may also be textual elements (document files), such as the name of the corresponding object (page), and col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure); and

a file controller which (i) registers at least one stored document file and causes page icons/thumbnails corresponding to a plurality of pages of the registered document file to be displayed in the list window area (col. 7, lines 47-65: each identifier within window is maintained in a list 111, the location in memory of the object represented by the identifier),

(iii) displays in the palette window area the page icons/thumbnails (col. 1, lines 32-57 and col. 4, lines 5-28),

(iv) performs an editing operation by manipulating the page icons/thumbnails displayed in the palette window area, said editing operation including picking up desired individual pages of the plurality of the pages of the at least one registered document file based on a designation of page icons/thumbnails in the palette window area corresponding to the desired individual pages (Abstract, col. 1, lines 32-57, col. 4, lines 5-28, col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: Conrad et al disclose that a graphical user interface allows user to drag an object (document file) when the user rolls over a hot spot on top of an icon or text representing a closed enclosure, and windows on the display corresponding to opened enclosures, wherein a window for an opened enclosure includes identifiers (icons/thumbnails) within the window corresponding to object enclosed by the opened enclosure),

However, Conrad does not explicitly disclose (ii) creates a document file having a predetermined file format corresponding to the registered document file in accordance with the registration and unifying the picked up individual pages, and (v) generates a new document file having the predetermined file format, and a corresponding new document file icon/thumbnail, in accordance with the editing operation. Takeda discloses in Figure 3 and pages 9-44 that documents are stored or registered in the data storage section 23 that stores documents, pages, file name type, number of documents or pages. Takeda discloses a method that enables a user to divide (division process) one document into plural pages or combine (unification process) several

documents into one (col. 14, line 18 – col. 15, line 53). Takeda also discloses that document can be divided at specified page such that Document 1 includes 3 pages, each page is considered as an individual page (col. 6, lines 55-67 and Fig. 6). In addition, Takeda discloses that using combination instruction and division instruction (file controller) from the menu on display screen to combine document and divide document, respectively (col. 14, lines 18-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Takeda and Conrad to include a document file having a predetermined file format corresponding to the registered document file in accordance with the registration and unifying the picked up individual pages, and (v) generates a new document file having the predetermined file format, and a corresponding new document file icon/thumbnail, in accordance with the editing operation. Takeda provides an image processing system, which can read manuscripts/documents and carry out image processing on the basis of the management information corresponding to the images of the read documents.

18. Claims 11, 27, 34, 37, 43, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conrad et al. (Conrad), US Patent No. 6,307,545 and Takeda et al. (Takeda), US Patent No. 6,549,302 as discussed in claims 3-5, 7, 12, 22-23, 29-33, 35-36, 38-42, 44-45, 47-55 above, and further in view of Stumbo et al. (Stumbo), US Patent No. 6,084,688.

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19. As to claims 11, 27, 34, 37, 43 and 46, Conrad-Takeda disclose wherein the new document file has a predetermined file format (Conrad, col. 4, lines 21-18) and Takeda discloses converting a scan document into an image document (col. 8, line 14 – col. 9, line 43). However, Conrad-Takeda do not explicitly disclose wherein said predetermined format is PDF format. Stumbo discloses converting an image into a portable document format or PDF (Stumbo, col. 1, lines 44-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Stumbo and Conrad-Takeda to include converting a document file into a PDF since the advantage of the portable document format is that it is page-independent and multi-page document converted into a PDF can be divided into subsets of data, and each subset of data corresponding to one of the multiple page images in the job or document. By doing this way, a number of individual page images in a multi-page document can be decomposed in parallel, thus reducing the amount of time required to decompose an entire multi-page document.

### ***Response to Arguments***

In the remarks, Applicant(s) argued in substance that

A) Takeda does not disclose picking up desired individual pages of the plurality of pages of the at least one selected registered document file based on a designation of

page icons/thumbnails in the palette window area corresponding to the desired individual pages, in the manner of the claimed present invention.

As to point A, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Conrad discloses col. 1, lines 32-57 and col. 4, lines 5-28: a display system 18 displaying a plurality of windows enclosed identifiers or icons (thumbnails) such as icons 26 and 27 in window 23, icons 28-30 in window 24 and icon 31 in window 25, and icons are shown as graphical elements and icons may also be textual elements (document files), such as the name of the corresponding object (page), and col. 11, lines 5-41, col. 12, lines 15-47 and Figs. 14A-B and 15A-B: a window (palette window) for an opened enclosure includes identifiers (document files) within the window corresponding to objects (pages) enclosed by the opened enclosure. Conrad also discloses in col. 7, lines 47-65: each identifier within window is maintained in a list 111, the location in memory of the object represented by the identifier (registered identifier (icon/thumbnail)). It would have been obvious to one of ordinary skill in the art to acknowledge that each identifier corresponding to object (page), and each object is individual object. However, to make it more clear, Examiner's introduced Takeda reference that teaches in Figure 3 and pages 9-44 that documents are stored or registered in the data storage section 23 that stores documents, pages, file name type, number of documents or pages. Takeda discloses a method that enables a user to

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divide (division process) one document into plural pages or combine (unification process) several documents into one (col. 14, line 18 – col. 15, line 53). Takeda also discloses that document can be divided at specified page such that Document 1 includes 3 pages, each page is considered as an individual page (col. 6, lines 55-67 and Fig. 6).

B) Takeda does not disclose, teach or suggest extracting a plurality of desired individual pages from a document and combining the desired individual pages into a new file.

As to point B, Takeda teaches in Figure 3 and pages 9-44 that documents are stored or registered in the data storage section 23 that stores documents, pages, file name type, number of documents or pages. Takeda discloses a method that enables a user to divide (division process) one document into plural pages or combine (unification process) several documents into one (col. 14, line 18 – col. 15, line 53). Takeda also discloses that document can be divided at specified page such that Document 1 includes 3 pages, each page is considered as an individual page (col. 6, lines 55-67 and Fig. 6).

20. Applicant's arguments filed 09/12/2005 have been fully considered but they are not persuasive. Please see the rejection and the response to arguments above.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The Examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen  
Patent Examiner  
Art Unit 2176

*William L. Bashore*  
WILLIAM BASHORE  
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11/23/2005